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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,117	07/19/2000	Richard L Atkinson		1999

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EXAMINER	
SALIMI, ALI REZA	
ART UNIT	**PAPER NUMBER**
1648	13

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/619,117	Atkinson et al
Examiner	**Art Unit**
A. R. SALMI	1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *Three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 9, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *2-8* is/are pending in the application.

4a) Of the above, claim(s) *4, 7, and 8* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *2, 3, 5, and 6* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/2002 has been entered.

Response to Amendment

This is a response to the Remarks, paper No.12, filed 4/9/2002. Claims 2-8 are pending in the application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Please note any grounds of rejection that has not been repeated is removed.

Election/Restriction

Claims 4, 7-8 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03, for reasons of record advanced in the previous Office Action mailed 9/28/99. Applicants argue that procedurally it is too late in the prosecution to require restriction among the invention. Applicant's argument as part of Paper NO. 12, filed 4/9/2002 has been considered fully, but they are not persuasive. The restriction requirement can be imposed any time during the prosecution given the fact that applicants had not presented now restricted claims prior to the first Office Action. In other words, if claims 4, 7-8 were present along with the originally field claims the claims would have been restricted out since they are directed to different and distinct invention, which apparently applicants do not dispute, since no argument has been made on the record to the contrary. The requirements is still deemed proper and is maintained. **Hence only claims 2, 3, 5, and 6 have been considered. Applicants are requested to cancel the claims in future correspondence.**

Claim Rejections - 35 USC § 112

Claims 2-3, 5-6 are rejected under 35 U.S.C. 112, second paragraph, for reasons of record advanced in the previous Office Action mailed 10/3/01. Applicants argue that the techniques of molecular biology and biological medicine have advanced to the point that detection of viruses is routine to those ordinary skill in the art. Applicants contend that hybridization conditions are

known. Applicants further assert that DNA sequence of the virus is known and a PCR analysis of the DNA in biological sample for the DNA sequence of the virus can be conducted. Applicants contend that the discovery here is that the virus causes obesity, and not the particular method used to identify the virus. Applicant's argument as part of Paper NO. 12, filed 4/9/2002 has been considered fully, but they are not persuasive. Applicants assertion are rather interesting, if every thing is known and is well within the purview of one of ordinary skill in the art then why should applicants be entitled to patent eligibility (emphasis added)? In order for one of ordinary skill in the art to practice the invention they should know what piece of DNA they can use in a method of detection, and what condition of hybridizations they can utilize to detect Ad36p. The invention is directed to various methods and as such the methods should layout steps that are "essential" to practice the claims. It is true that the PCR is known, and it is true that the claims are not directed to a general method of PCR or ELISA, but applicants' claims should clearly state what the steps are so that one of ordinary skill in the art can follow to determine whether or not someone is suffering from viral obesity caused by adenovirus type 36p or not. As it was clearly stated previously the claims are deficient for not reciting the conditions for practicing the methods. The claims have been examined in light of the specification and since the specification does not set forth the conditions and how the determination is made the claims are considered indefinite. What are the intended immunoanalytical or nucleic acid probe(s) utilized in now claimed method(s)? What are the conditions of hybridization, is low stringency sufficient? If low stringency conditions are sufficient, then what is the guarantee that the signal is actually Ad36p? How is the detection

made? If the ELISA assay is intended, then a specific antigen of Ad36p is needed so one ordinary skill in the art can use to detect the virus. The essential steps for detecting the virus Ad type 36p are missing. The claim should clearly state what steps are needed. The rejection is maintained.

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is (703) 305-3014, or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. R. Salimi

5/8/2002

ALI R. SALIMI
PRIMARY EXAMINER